

WIRTH  
Serial No. 09/987,438

### REMARKS

Reconsideration of this application is respectfully requested.

Upon entry of this Amendment, the title of the invention will be amended.

In a Communication from the Examiner dated June 30, 2005, the Examiner suggested a small modification to the new title proposed in the Amendment filed in this application on February 23, 2005. The title of the invention has now been amended to conform to the title suggested by the Examiner. In view of this further revised title, the Examiner's objection to the title should now be withdrawn.

In the June 30, 2005 Communication from the Examiner, the Examiner also withdrew from further consideration claims 1 – 52, as amended in the February 23, 2005 Amendment, "based on a constructive election by original presentation." To justify his withdrawal of claims 1-52, the Examiner asserts that the amendments to the claims "have introduced a new inventive concept", citing 37 CFR §1.142(b) and MPEP §821.03.

MPEP §821.03 states that "[c]laims added by Amendment following action by the examiner, . . . to an invention other than previously claimed, should be treated as indicated by 37 CFR 1.145." Section 1.145, titled *Subsequent presentation of claims for different invention*, states:

If, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed

if the amendment is entered, subject to reconsideration and review as provided in §§ 1.143 and 1.144.

(Emphasis added). In the present application, contrary to the Examiner's assertion in his June 30, 2005 Communication, claims 1-52, as amended in the February 23, 2005 Amendment, are not directed to a different invention from the invention described in claims 1-52, as originally filed in the present application.

Section 1.145 refers to "an invention distinct from and independent of the invention previously claimed." MPEP §802.01 defines the terms "independent" and "distinct" used in §1.145. The term "independent" is defined by §802.01 as follows:

The term "independent" (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect, for example: (1) species under a genus which species are not usable together as disclosed; or (2) process and apparatus incapable of being used in practicing the process.

The term "distinct" is defined by §802.01 as follows:

The term "distinct" means that two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (though they may each be unpatentable because of the prior art). It will be noted that in this definition the term related is used as an alternative for dependent in referring to subjects other than independent subjects.

There were three independent claims originally filed in the present application, *i.e.*, claims 1, 25 and 39. Both of method claims 1 and 25, as originally filed, recited the steps of comparing potential customers' login names with stored names, and if a login name corresponded to one of the stored names, transmitting to the potential customers' second device a promotional offer. Similarly, system claim 39, as originally filed, recited a program stored in a first device for comparing potential customers' login names with stored names, and if any one of the login names corresponded to one of the stored names, transmitting to the corresponding potential customer's second device a promotional offer. Originally-filed dependent claims 20 and 34, which depend from independent claims 1 and 25, respectively, further recited that the step of comparing the corresponding person's login name with the stored names further comprised allowing for mis-keyed or misspelled entries in the stored names.

In the February 23, 2005 Amendment, independent claims 1, 25 and 39 were amended to recite that when a potential customer's login name is compared with stored names, a program allows the matching of the login name with stored names in the instances of mis-keyed or misspelled name entries, to thereby allow access to an E-commerce website by the customers.

By asserting that amended claims 1-52 define a new inventive concept, the Examiner is, in effect, contending that amended independent claims 1, 25 and 39 are

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directed to an invention that is distinct from, and independent of, the present invention as described in originally-presented independent claims 1, 25 and 39. In fact, amended independent claims 1, 25 and 39 are not directed to an invention that is distinct from, and independent of, the present invention as described in originally presented claims 1, 25 and 39 for several reasons.

MPEP §802.01, in defines the term “independent” to mean “no disclosed relationship between the two or more subjects disclosed”, that is, that the two or more subjects disclosed “are unconnected in design, operation, or effect”. It gives as two examples of this (1) species under a genus that are not usable together as disclosed and (2) process and apparatus incapable of being used in practicing the process. Neither of these examples apply to claims 1-52 of the present application. Moreover, clearly, amended claims 1, 25 and 39 and originally-filed claims 1, 25 and 39 do not describe “two or more subjects” that are disclosed in the present application. In fact, there is a relationship between the subject matter of originally-filed claims 1-52 and amended claims 1-52, such that they are connected in design, operation and effect. Both sets of independent claims define the same method and system to get orders via a telecommunications network or website located on the Internet. The only difference between the method and system described in both sets of independent claims is that the method and system described in amended independent claims 1, 25 and 39, in comparing the login names with the stored names, compensate for mis-keyed or misspelled name

entries.<sup>1</sup> But even the “added” feature of compensating for mis-keyed and misspelled login names was included in originally-filed claims 1-52. As noted by the Examiner in his June 30, 2005 Communication, dependent claims 20 and 34, which depend from independent claims 1 and 25, respectively, described the step of comparing login names with stored names as allowing for mis-keyed or misspelled entries in the stored names. Nevertheless, and interestingly, at the time that the Examiner issued the first Office Action in this application on September 28, 2004, he made no mention of compensating for mis-keyed or misspelled entries in comparing login names with stored names as being “a new inventive concept” so as to subject the application to an election/restriction requirement.

Amended independent claims 1, 25 and 39 are also not “distinct from” original independent claims 1, 25 and 39, as that term is defined in MPEP §802.01. In defining the term “distinct” as meaning that two or more subjects as disclosed are related, for example, as (1) combination in part (subcombination thereof), (2) process and apparatus for its practice, and (3) process and product made, *etc.*, MPEP §802.01 further requires that the two or more subjects as disclosed be “capable of separate manufacture, use, or sale as claimed . . .” (Emphasis added). Here again, clearly, amended claims 1, 25 and 39 and originally-filed claims 1, 25 and 39 do not describe “two or more subjects” that

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<sup>1</sup> Such claims also recite transmitting a standard welcome if a login name being compared does not correspond to one of the stored names.

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are disclosed in the present application. As noted above, they are directed to the same method and system for getting orders via a telecommunications network or Internet website, except that claims 1, 25 and 39, as amended, now recite the step of allowing for mis-keyed or misspelled entries in comparing login names with stored names. Because the step of allowing for mis-keyed or misspelled names, as claimed in amended claims 1, 25 and 39, relies on the other steps recited in claims 1, 25 and 39 to obtain the stored names and login names that are compared for mis-keyed or misspelled names, clearly the step of allowing for mis-keyed or misspelled entries in company login names with stored names is not capable of separate manufacture, use, or sale, as claimed.

In sum, amended claims 1-52 do not describe a “different invention” from the present invention, as described in originally-filed claims 1-52. As such, the Examiner’s withdrawal of claims 1-52 from further consideration, based on a constructive election by original presentation, should be withdrawn.

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In view of the foregoing, it is now believed that claims 1-52 are in condition for allowance, which action is earnestly solicited. If any issues remain in this application, the Examiner is urged to contact the undersigned at the telephone number listed below.

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